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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,122	02/28/2006	Christine Power	ARS-122	7430

23557 7590 12/17/2009

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EXAMINER	
DEBERRY, REGINA M	

ART UNIT	PAPER NUMBER
1647	

NOTIFICATION DATE	DELIVERY MODE
12/17/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

euspto@slspatents.com

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/570,122	**Applicant(s)** POWER ET AL.	
	Examiner Regina M. DeBerry	**Art Unit** 1647	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *46-50,55 and 57-60*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Marianne P. Allen/
Primary Examiner, Art Unit 1647

Continuation of 11. does NOT place the application in condition for allowance because: Claims 46-50, 55, 57-60 remain rejected under 35 U.S.C. 102(e) as being anticipated by Tang et al. (reference submitted by Applicant; WO 02/074961 A1). The basis for this rejection is set forth at pages 2-4 of the previous Office Action (12 August 2009).

Applicant cites Tang et al. (page 7, lines 3-7). Applicant argues that the polypeptide corresponding to SEQ ID NO:913 is not associated with a polypeptide useful for the treatment of liver or lung fibrosis. As was argued by Applicant in previous arguments (22 May 2009), Applicant states that Table 2 indicates that the polypeptide has homology to the human SEC protein of the sec oncogene and maintains that at best, one skilled in the art, in view of the teachings of the reference, would have used the polypeptide associated with SEQ ID NO:913 in methods of detecting cancers or possibly for detecting elements of the human hematopoietic/immune systems. Applicant cites the Examiner arguments from the previous Office Action (12 August 2009). Applicant argues that the Examiner's rationale for maintaining the rejection of record is improper as it requires one skilled in the art to ignore the expressed teachings of Tang et al. Applicant argues that the rejection is improper as it requires one skilled in the art to pick and choose various disclosures within Tang et al. that are not directly related to one another and then proceed in a manner completely contrary with respect to how the reference teaches one to used the disclosed polypeptide. Applicant cites case law Sanofi-Synthelabo v. Apotex, Inc. Applicant argues against the references submitted by the Examiner. Applicant states that Tischer et al. and Vukicevic et al. do not teach that the individual members of a superfamily of proteins have opposite activities.

Applicant's arguments have been fully considered but are not found persuasive. Firstly the passage cited by Applicant states, "..the polypeptides of the present invention and the polynucleotides encoding them ARE ALSO USEFUL for the same functions known to one of skill in the art as the polypeptides and polynucleotides to which they have homology. One skilled in the art understands "are also useful" to mean "in addition to"; that is to say that the polypeptide IS NOT ONLY employed in methods of detecting elements of the human hematopoietic/immune system or methods of detecting cancer as argued by Applicant. Applicant misread the Examiner arguments regarding the submitted references. Tischer and Vukecivic were submitted in the previous Office Action (12 August 2009) to demonstrate that the assertion that the disclosed polypeptide has biological activities similar to known human SEC protein of the sec oncogene cannot be accepted because the literature reports examples of polypeptide families wherein individual members have distinct, AND SOMETIMES EVEN OPPOSITE, biological activities. The fact that the protein is homologous to the human SEC protein does not "lock the protein" in to only

having biological functions of the hematopoietic/immune system or cancer as maintained by Applicant. Applicant's statement that the rejection is improper as it requires one skilled in the art to pick and choose various disclosures in Tang et al. and the citation of case law (Sanofi-Synthelabo v. Apotex, Inc.) are not found persuasive. The Sanofi-Synthelabo v. Apotex, Inc. case law states, "..federal district court did not clearly err in finding that two prior art patents disclosing “racemate PCR 4099,” which is a combination of dextrorotatory and levorotatory enantiomers of specific compound, do not anticipate invention of claim in patent for clopidogrel compositions used in blood platelet aggregation inhibiting agent, which recites bisulfate salt of dextrorotatory enantiomer of same compound substantially separated from its levorotatory enantiomer, since disclosure of genus in prior art is not necessarily disclosure of every species within its scope, since references state generally that racemate compounds consist of enantiomers, but nothing in reference disclosure would have led person of ordinary skill in art to recognize either explicit or inherent disclosure of racemate's dextrorotatory enantiomer and its bisulfate salt, and since knowledge that enantiomers exist, and that they may be separated, is not “anticipation” of specific enantiomer that has not been separated, identified, and characterized..". However, Tang et al. clearly teach that the composition of the present invention is useful for treatment of lung or liver fibrosis (page 55, lines 24-26). In addition, MPEP 2131.02 states a genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species is anticipated no matter how many others are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). Further, MPEP 2141.02 [R-5] VI states that the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed. In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

The scientific reasoning and evidence as a whole indicates that the rejection should be maintained.